

### **REMARKS**

This is in full and timely response to the non-final Official Action of September 15, 2008. Reexamination in light of the following remarks is respectfully requested. No new matter has been added.

Claims 3-5 and 8-13 are currently pending in this application, with claims 3-5 and 8-13 being independent.

#### **I. Information Disclosure Statement**

Applicant thanks the Examiner for providing an initialed copy of forms PTO/SB/08a/b, which were submitted by the Applicant on December 16, 2004, August 22, 2005, July 23, 2007, December 14, 2007, February 14, 2008 and August 28, 2008.

#### **II. Priority Documents**

It is noted with appreciation that the Office Action has acknowledged receipt of the claim for priority and the certified document supporting that claim.

#### **III. Claim Rejections – 35 U.S.C. §112**

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that claims 1 and 6 recite the terms “read-in” and/or “reading-in.” The rejection is respectfully traversed for reasons set forth below.

By the foregoing amendment, the claims 1 and 6 have been canceled. Therefore, the rejection is now moot. Withdrawal of the rejection is respectfully requested.

Claims 2 and 7 are rejected as they recite “characteristics intrinsic to said specification”. Specifically, the Office Action asserts that it is vague and indefinite what characteristics are intrinsic to the specification.

By the foregoing amendment, claims 2 and 7 have been canceled. Therefore, the rejection is now moot. Withdrawal of the rejection is respectfully requested.

#### **IV. Claim Rejections – 35 U.S.C. §101**

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

By the foregoing amendment, the remaining claims 3-5 and 8-10 have been amended so as to be directed to statutory subject matter. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

#### **V. Claim Rejections – 35 U.S.C. §102**

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Barney et al., U.S. Patent Number 6,556,992 B1. The rejection is respectfully traversed for reasons set forth below.

As a preliminary matter, claims 1, 2, 7 and 8 have been canceled.

##### **1. Claim 3**

Claim 3 is directed to a program product stored in a computer readable medium that permits a computer to implement the following steps of: a specification analysis step of reading in a specification and analyzing said specification so as to obtain a number of words for preferred embodiment and a number of words of claims; a patent value calculation step of calculating a patent

value using the following formula: {the number of words for preferred embodiment/the number of words for claims}; and a patent value output step of outputting said patent value.

Barney arguably teaches a method and a system for valuing patents. However, the applied art fails to disclose, teach or suggest “a patent value calculation step of calculating a patent value using the following formula: {the number of words for preferred embodiment/the number of words for claims}.” Thus, the applied art does not anticipate claim 3. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

## **2. Claim 4**

Claim 4 is directed to a program product stored in a computer readable medium that permits a computer to implement the following steps of: a specification analysis step of reading in a specification and analyzing said specification so as to obtain the smallest number of elements composing one claim; a patent value calculation step of calculating a patent value using the smallest number of elements composing one claim obtained by the specification analysis step, as a parameter; and a patent value output step of outputting said patent value.

However, the applied art fails to disclose, teach or suggest “a specification analysis step of reading in a specification and analyzing said specification so as to obtain the smallest number of elements composing one claim; a patent value calculation step of calculating a patent value using the smallest number of elements composing one claim obtained by the specification analysis step, as a parameter.”

Thus, the applied art does not anticipate claim 4. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

## **3. Claim 5**

Claim 5 is directed to a program product stored in a computer readable medium that permits a computer to implement the following steps of: a specification analysis step of reading in a

specification and analyzing said specification so as to obtain a depth of claim nesting level or a number of claim categories; a patent value calculation step of calculating a patent value using the depth of claim nesting level or the number of claim categories obtained in said specification analysis step, as a parameter; and a patent value output step of outputting said patent value.

However, the applied art fails to disclose, teach or suggest “a specification analysis step of reading in a specification and analyzing said specification so as to obtain a depth of claim nesting level or a number of claim categories; a patent value calculation step of calculating a patent value using the depth of claim nesting level or the number of claim categories obtained in said specification analysis step, as a parameter.” Thus, the applied art does not anticipate claim 5. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

#### **4. Claim 8**

Claim 8 is directed to a data processing device comprising: a specification reader for reading in a specification; a specification analyzer for analyzing said specification; a patent value calculator for calculating a patent value based on the following formula: {a number of words for preferred embodiment/number of words for claims}; and a patent value output means for outputting said patent value.

However, the applied art fails to disclose, teach or suggest “a patent value calculation step of calculating a patent value using the following formula: {the number of words for preferred embodiment/the number of words for claims}.”

Thus, the applied art does not anticipate claim 8. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

#### **5. Claim 9**

Claim 9 is directed to a data processing device as set forth in claim 7, comprising: a specification reader for reading in a specification; a specification analyzer for analyzing said

specification so as to obtain a smallest number of elements composing one claim; wherein said characteristics include at least an inventive feature extraction level, and said a patent value calculation part calculator for calculates calculating at least said inventive feature extraction level a patent value using a the smallest number of elements composing one claim obtained in the specification analyzer, as a parameter; and a patent value output means for outputting said patent value.

However, the applied art fails to disclose, teach or suggest “a specification analyzer for analyzing said specification so as to obtain a smallest number of elements composing one claim; a patent value calculator for calculating a patent value using the smallest number of elements composing one claim obtained in the specification analyzer, as a parameter.”

Thus, the applied art does not anticipate claim 9. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

## **6. Claim 10**

Claim 10 is directed to a data processing device comprising: a specification reader for reading in a specification; a specification analyzer for analyzing said specification so as to obtain a depth of claim nesting level or a number of claim categories; a patent value calculator for calculating a patent value using the depth of claim nesting level or the number of claim categories obtained in the specification analyzer, as a parameter; and a patent value output means for outputting said patent value.

However, the applied art fails to disclose, teach or suggest “a specification analyzer for analyzing said specification so as to obtain a depth of claim nesting level or a number of claim categories; a patent value calculator for calculating a patent value using the depth of claim nesting level or the number of claim categories obtained in the specification analyzer, as a parameter.”

Thus, the applied art does not anticipate claim 10. Therefore, withdrawal of the rejection and allowance of the claim is respectfully requested.

## **VI. Conclusion**

In view of the following arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers.

**Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully requests that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.**

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. IRD-0002 from which the undersigned is authorized to draw.

Dated: December 9, 2008

Respectfully submitted,

By /Toshikatsu Imaizumi/  
Toshikatsu Imaizumi, Reg. #61,648  
RADER, FISHMAN & GRAUER PLLC  
Correspondence Customer Number: 23353  
Attorney for Applicants